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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/025,787 | 12/26/2001 | Renato Caretta | 07040.0113 | 5883 |

22852 7590 01/02/2008
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
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| EXAMINER |
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VARGOT, MATHIEU D

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| ART UNIT | PAPER NUMBER |
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1791

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| MAIL DATE | DELIVERY MODE |
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01/02/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/025,787 | CARETTA, RENATO | |
| | Examiner | Art Unit | |
| | Mathieu D. Vargot | 1791 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 34-37 and 39-66 is/are pending in the application.
- 4a) Of the above claim(s) 48-66 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 34-37 and 39-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1.Applicant's election with traverse of Group I in the reply filed on October 2, 2007 is acknowledged. The traversal is on the ground(s) that examination of both the method and apparatus would not pose a burden on the office, and at any rate, they both were examined the in office action of March 26, 2004. This is not found persuasive because the apparatus can be used to practice methods other than that set forth in the claims as presently amended, as generally set forth in the restriction requirement.

The requirement is still deemed proper and is therefore made FINAL.

2.The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 34-37 and 39-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clinefelter in view of Logan.

Clinefelter is applied for reasons of record, the primary reference teaching the basic claimed method lacking essentially the aspect of the expansion step performing an admission of a working fluid at a lower pressure than that of the fluid under pressure admitted during the expanding step. Logan teaches this and such would have been an obvious modification to the method of Clinefelter to facilitate the expansion of the tire against the mold and assist in centering the tire—see Logan, column 2, lines 6-46. Note that such is fairly conventional in the art and it is certainly within the skill level of the art to employ known steps to facilitate tire expansion and ultimately allow for a more uniform vulcanization. Logan also teaches admission of a heating fluid (col. 3, lines 3-4)

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for vulcanizing the tire. The operation of the primary reference would allow for the guiding as set forth in instant claim 40. As already set forth, the limitation of instant claim 41 is submitted to be obvious over Clinefelter in order to ensure that the vulcanizing fluid stays at the right vulcanizing temperature. The exact dimensions of the diffusion interspace and tire expansion would have been within the skill level of the art and would be readily determined dependent on tire and mold size. Clinefelter builds the tire on the core—see page 1, lines 97+ of the primary reference. Instant claims 46 and 47 are conventional in the art and would have been obvious steps in the tire building of the primary reference to ensure that the expansion fluids do not leak through the tire.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 34-37 and 39-47 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-19 of U.S.

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Patent No. 6,479,008. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims and those of US Patent -008 to Caretta set forth essentially the same inventive method concerning the admission of a preliminary fluid—see claim 8 of US Patent -008. See also claims 13-19 of the patent applied.

5. Claims 34-37 and 39-47 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 6,332,999 in view of Logan. The double patenting rejection over US Patent 6,332,999 has been maintained but has been supported by the disclosure of Logan, which teaches a preliminary expansion, such seen to be the primary difference between the instant claims and that set forth in US Patent -999 to Caretta. It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the method as set forth in the claims of US Patent -999 with a preliminary expansion as taught by Logan to more accurately seat and vulcanize the tire.

6. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

The rejection has been changed in view of the amendment and the discovery of the new reference to Logan, such seen to render the instant claims obvious in combination with Clinefelter. Hence, applicant's comments in the response of July 28, 2004 concerning the application of Clinefelter alone are not probative. The double patenting rejection over US Patent 6,332,999 has been maintained, albeit in combination with Logan, and an additional double patenting rejection has been made over US Patent 6,479,008.

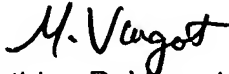
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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mathieu D. Vargot whose telephone number is 571 272-1211. The examiner can normally be reached on Mon-Fri from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson, can be reached on 571 272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M. Vargot
December 21, 2007


Mathieu D. Vargot
Primary Examiner
Art Unit 1791
12/21/07